



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,412	10/12/2000	Howard J. Glaser	STL920000092US1	1235

24852 7590 04/16/2004

INTERNATIONAL BUSINESS MACHINES CORP
IP LAW
555 BAILEY AVENUE , J46/G4
SAN JOSE, CA 95141

EXAMINER

GROSS, KENNETH A

ART UNIT	PAPER NUMBER
----------	--------------

2122

DATE MAILED: 04/16/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/687,412

Applicant(s)

GLASER ET AL.

Examiner

Kenneth A Gross

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites “determining if the item described in the user configuration has been updated producing an updated item” and “retrieving the updated if the item has been updated” (lines 10-12). It is unclear from this claim language why, if an item has already been updated, assumingly on the user’s computer, is the updated item retrieved and built on the user’s computer, when the user configuration already shows that the item has been updated on the user’s computer? If an item “has been updated”, does this imply that an update of a given item is available elsewhere? This argument can be applied to corresponding Claims 2, 3, 6-8, and 11-13. Clarification is requested. Claims 4, 5, 9, 10, 14, and 15 are rejected for being dependent on a rejected parent Claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

Art Unit: 2122

the invention. Specifically, Claim 1 recites "determining if the item described in the user configuration has been updated producing an updated item", which is unclear. Does this imply that the application program has already been produced for the user? Or does this imply that only the item in the user configuration has been updated? This argument can be applied to corresponding Claims 6 and 11. Claims 2-5, 7-10, and 12-15 are rejected for being dependent on a rejected parent Claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (U.S. Patent Number 6,314,565) and further in view of Stedman et al. (U.S. Patent Number 6,262,726).

In regard to Claim 1, Kenner teaches: (a) defining a configuration of the application program, the user configuration describing an item from which the application program may be built (Column 7, lines 5-12); (c) determining if the item described in the configuration has been updated producing an updated item (Column 7, lines 12-16); (d) retrieving the updated item if the item has been updated (Column 8, lines 18-29); (e) building the application program with the updated item (Column 8, lines 30-41). Kenner does not teach that the configuration of the

Art Unit: 2122

application program is a user configuration, nor does he teach determining that the user configuration corresponds to the particular user. Stedman, however, does teach storing user configurations of an operating system for the purposes of application customization (Column 6, lines 58-62), and further teaches authenticating a particular user when the particular user attempts to initialize the operating system (Column 6, lines 55-58), and hence assuring that the user configuration corresponds to the user being authenticated. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to define a configuration of the application program, determine if any items described in the configuration have been updated, retrieve an updated item if the item has been updated, and build the application program with the updated item, as taught by Kenner, where the configuration of the application program is a user configuration, and determining that the user configuration corresponds to the particular user, as taught by Stedman, since this allows different users to access different requested software from the same machine.

Claims 6 and 11 are method and system Claims that correspond to the article of manufacture Claim 1, and Claims 6 and 11 are rejected for the same reasons as Claim 1, where Kenner teaches a method (Figure 2) and system (Figure 1) for article of manufacture Claim 1.

7. Claims 2, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (U.S. Patent Number 6,314,565) in view of Stedman et al. (U.S. Patent Number 6,262,726) and further in view of Hsu (U.S. Patent Number 5,894,515).

For specific rejections of Claims 2, 7, and 12, see the office action mailed on October 27th, 2003.

8. Claims 3, 4, 8, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515) and further in view of Hayes, Jr. (U.S. Patent Number 6,205,476).

For specific rejections of Claims 3, 4, 8, 9, 13, and 14, see the office action mailed on October 27th, 2003.

9. Claims 5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner et al. (U.S. Patent Number 6,314,565) in view of Hsu (U.S. Patent Number 5,894,515) and further in view of Hayes, Jr. (U.S. Patent Number 6,205,476) and Houssain et al. (U.S. Patent Number 5,581,749).

For specific rejections of Claims 5, 10, and 15, see the office action mailed on October 27th, 2003.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAG

A handwritten signature in black ink, reading "Hoang Anthony Nguyen Ba". The signature is written in a cursive, flowing style.

**ANTONY NGUYEN-BA
PRIMARY EXAMINER**